

## **REMARKS**

### **I. INTRODUCTION**

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

### **II. STATUS OF THE CLAIMS**

Claims 1–20 are pending; Claim 1 is amended; and Claim 20 is newly added herewith. It is respectfully submitted that no new matter is added by this amendment.

### **III. SUMMARY OF THE OFFICE ACTION**

In the outstanding Office Action, Claims 1–4 and 6–8 were rejected under 35 U.S.C. § 102(b) as anticipated by *Kuroda* (U.S. Patent No. 5,331,514). Additionally, Claims 6–8 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Kuroda* and *Uematsu, et al.* (U.S. Patent No. 6,787,710, hereafter *Uematsu*). Applicants acknowledge with appreciation the indication that Claims 5 and 9–19 contain allowable subject matter.

### **IV. REJECTIONS UNDER 35 U.S.C. § 102**

As noted above, the outstanding Office Action states that Claims 1–4 and 6–8 were rejected under 35 U.S.C. § 102(b) as anticipated by *Kuroda*. However, because the outstanding Office Action admits at page 4 that *Kuroda* does not disclose or suggest the features of Claims 6–8, this response addresses the rejection of Claims 1–4 and 6–8 under 35 U.S.C. § 102 as though it only relates to Claims 1–4.

Independent Claim 1 recites, in part: “at least one routing channel positioned between at least two of the plurality of rows.” Support for this amendment may be found, at least, in paragraph [0063] of the published specification. As this feature is not disclosed or suggested by

*Kuroda*, it is respectfully submitted that Claim 1 and Claims 2–4 patentably distinguish over *Kuroda*.

Moreover, it is respectfully submitted that *Kuroda* fails to disclose the features of Claims 2–4. Since the Office Action has not cited to any specific teachings in support of the rejection, it appears that the outstanding Office Action is asserting that the features of Claims 2–4 are inherent in the teachings of *Kuroda*.

However, as set forth in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Moreover, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Because the outstanding Office Action has not satisfied the burden of proof set forth in MPEP § 2112, it is respectfully submitted that the outstanding Office Action has not provided a *prima facie* case of anticipation with respect to Claims 2–4. Accordingly, it is respectfully submitted that Claims 2–4 further patentably distinguish over *Kuroda*.

Therefore, because *Kuroda* does not disclose or suggest the features of Claims 1–4, it is respectfully requested that this rejection be withdrawn.

**V. REJECTIONS UNDER 35 U.S.C. § 103**

Claims 6–8 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Kuroda* in view of *Uematsu*. For the reasons discussed below, this rejection is respectfully traversed.

Claims 6–8 depend from Claim 1. As noted above, *Kuroda* does not disclose or suggest the features of independent Claim 1. Therefore, as *Uematsu* is not relied upon to provide the features identified as deficient in *Kuroda*, *Uematsu* is not substantively addressed herewith.

Moreover, it is respectfully submitted that there is no basis in the teachings of either of these references to support the applied combination. Certainly, the outstanding Office Action does not cite to any specific teachings within either *Kuroda* or *Uematsu* to support this combination. As a result, it is respectfully submitted that the applied combination of *Kuroda* with *Uematsu* is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper.

Thus, as the outstanding Office Action has not provided a *prima facie* case of obviousness with respect to Claims 6–8, it is respectfully requested that this rejection be withdrawn.

**VI. ALLOWABLE SUBJECT MATTER**

Applicants acknowledge with appreciation the indication that Claims 5 and 9–19 contain allowable subject matter. Newly added Claim 20 reflects the subject matter of Claim 5 in independent form. Accordingly, it is respectfully submitted that Claim 20 does not present any new subject matter and is in condition for allowance.

**VII. CONCLUSION**

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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Atty. Docket No.: 000309-00032  
**Date: May 16, 2006**  
PSW/KPB/rc